

## REMARKS

Claims 1-3 remain pending in this application. None of the claims have been amended in this Response.

Claims 1 and 2 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Winell* (US Patent 6,625,145) in view of *Wang* (US Patent 6,614,774), further in view of *Watanuki et al.* (US Patent 6,172,986). Claim 3 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

The cited art, alone or in combination, does not disclose the features of the present invention. Specifically, the Examiner stated that “*Winnell* does not disclose the limitations of reading a node identifier corresponding to a host name of the second node input and the home prefix of the second node” (page 3, lines 8-10 of Office Action), and yet concurrently states that *Winnell* discloses “generating an IP address having the node identifier and home prefix.” It is axiomatic that if *Winnell* does not disclose “reading a node identifier” as recited in claim 1, then the reference cannot also teach “generating an IP address” (along with the remainder of the limitations) that rely on that same node identifier. In establishing prima facie obviousness, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Furthermore, the combination of references as proposed in the Office Action rely on impermissible hindsight. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (MPEP 2143.01). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2143).

*Winell* teaches a system and method wherein the lower address bits of an IP address are used as a mobile station's short identifier (col. 4, lines 39-40; col. 5, lines 24-32). When the operator of a node is assigned multiple networks from an ISP having the same high-order bits, *Winell* teaches that the lower bits of the IP-address are directly mapped to a unique key value

that is used within that node (col. 4, lines 41-47; col. 5, line 63 to col. 6, line 3). During a translation process between the host and the mobile station, *Winell* simply adds or removes the high-order bits to convert the IP-address into the mobile station identifier (col. 4, lines 52-54; col. 6, lines 4-26). Through this configuration the address translation process is simplified by providing a common software path for mobile stations communicating with a node having identical IP addresses within that node (col. 6, lines 41-59).

Since *Winell* teaches address translation within the same IP address, what motivation or suggestion would there be to modify *Winell* with the teaching in *Wang* and *Watanuki* as suggested by the Office Action? Since *Wang* (col. 7, lines 8-11) and *Watanuki* (col. 1, lines 1-14) expressly rely on a plurality of IP networks and addresses, the teaching in those references run contrary to the principle of operation disclosed in *Winell* (MPEP 2143.02). Accordingly, the motivation stated in the Office Action is improper and should be withdrawn.

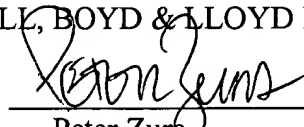
For at least these reasons, the Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn. An early Notice of Allowance is earnestly requested.

If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0113184-0004) on the account statement.

Respectfully submitted,

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